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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,089	06/20/2005	Munetake Ebihara	09812.0753-00000	4198

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/510,089

Applicant(s)

EBIHARA ET AL.

Examiner

DIANE D. MIZRAHI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-4-04</u> . | 6) <input type="checkbox"/> Other: ____. |

III. DETAILED ACTION

Claims 1-19 are presented for examination.

Drawings

The Examiner contends that the drawings submitted on October 4, 2004 are acceptable.

Claim Rejections - 35 USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is “useful, tangible and concrete.

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that “A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility
<http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicants claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the “practical application, result, concrete, useful and tangible” limitations are not claimed in Applicant’s claims, Examiner believes that the above listed claims are nonstatutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonathan Clark (US Patent No. 6,343,280 B2 and Clark hereinafter).

Regarding Claim 1, Clark teaches an information processing apparatus for performing a content use eligibility determination process , comprising: a storage unit for storing a property list that is an attribute information list of the information processing apparatus, and a usage condition interpretation module for performing the content use eligibility determination process (col 4, lines 19-48) through a checking process of checking a property selection list contained in content usage condition information against the property list stored in the storage unit (col 6,

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lines 60-67 to col 12, lines 1-60), wherein the usage condition interpretation module performs a determination process of determining whether data corresponding to property definition data as data constituting the property selection list is present in the property list, and in accordance with a process sequence that decides a next process step based on the result of the determination process and a process setting code (col 4, lines 19-48) (col 16, lines 37-67 to col 17, lines 1-22) accompanying the property definition data, the usage condition interpretation module performs the content use eligibility determination process (col 6, lines 60-67 to col 12, lines 1-60) (col 12, lines 61-67 to col 13, lines 1-13) (col 13, lines 57-67 to col 14, lines 1-10).

Regarding Claim 2, Clark teaches wherein the property list stored in the storage unit contains identification information and function information of the information processing apparatus, and wherein the usage condition interpretation module performs a determination process of determining whether the identification information and the function information of the information processing apparatus corresponding to the property definition data as the data constituting the property selection list are contained in the property list (col 21, lines 10-61) (col 17, lines 24-46).

Regarding Claim 3, Clark teaches wherein the content usage condition information contains a parameter corresponding to the property definition data as the data constituting the property selection list, and wherein the usage condition interpretation module performs a determination process of the content usage condition based on the parameter (col 17, lines 24-46).

Regarding Claim 4, Clark teaches wherein the property list stored in the storage unit is set on per library unit basis with a library unit as a category corresponding to the usage of the content, and wherein the usage condition interpretation module performs the content use eligibility determination process through a checking process with the property selection list indicating the content usage condition information of a content usage corresponding to the property list stored in the storage unit on a per library unit basis (col 21, lines 10-61).

Regarding Claim 5, Clark teaches wherein the property list stored in the storage unit includes any of text data, code data, and numerical data, and wherein the usage condition interpretation module performs a determination process of determining whether any of the text data, the code data, and the numerical data matching the property definition data as the data constituting the property selection list is contained in the property list stored in the storage unit (col 23, lines 20-67 to col 24, lines 1-6).

Regarding Claim 6, Clark teaches a content key acquisition processor for performing an acquisition process of acquiring a content key applied to a decrypting process of an encrypted content, wherein the content key acquisition processor performs the acquisition process of the content key on condition that the usage condition interpretation module determines in the content use eligibility determination process that content use is permitted (col 15, lines 34-67 to col 16, lines 1-36)(col 28, lines 60-67 to col 29, lines 1-21)(col 31, lines 50-67 to col 32, lines 1-65).

Regarding Claim 7, Clark teaches wherein the content key acquisition processor performs

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the key acquisition process through a decrypting process of decrypting an enabling key block (EKB) based on a device node key (DNK) provided to the information processing apparatus in a hierarchical key delivery arrangement (col 15, lines 34-67 to col 16, lines 1-36)(col 28, lines 60-67 to col 29, lines 1-21)(col 31, lines 50-67 to col 32, lines 1-65).

Regarding Claims 8-19, these claims are similar in scope to the rejected claims above and are therefore rejected as set forth above.

Other Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Conclusion

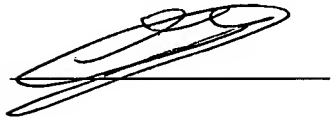
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Diane Mizrahi', written over a horizontal line.

Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

October 11, 2006